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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/276,716	03/26/99	YOKOTA	M 0020-4539P

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EXAMINER

BUTTNER, D

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

9-276716

Applicant(s)

YOKOTA

Examiner

BUTNER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12/26/00
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Asakura '664 Patent.

Asakura exemplifies (C5) a three piece golf ball having a soft outer cover and a filled harder inner cover. The core has a deformation of 4.8. Presumably, the hardness of the core is uniform since the reference does not say otherwise.

The reference does not measure JIS-C hardness. However it is known that two stage vulcanized cores of such composition and deformation inherently have JIS-C values within applicant's range (see Moriyama '856 col. 3 line 11, 16, 59 and table 3).

Claims 1, 2 and 5-14 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Moriyama '802 Patent.

Moriyama '802 exemplifies (#1-3) three layer balls having a soft outer cover and a hard inner cover. The core has a deformation of 3.7 to 5.0 (col. 3 line 5).

The reference does not measure JIS-C hardness. However is known that such cores inherently have uniform JIS-C values within the claimed range (see Tanaka '663's tables and vulcanization method).

Claims 1, 2 and 5-14 rejected under 35 U.S.C. 103(a) as being unpatentable over the Moriyama '802 Patent in view of Tanaka '663.

Moriyama does not measure his core's JIS-C hardness or uniformity thereof.

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It is known that cores with uniform hardness improves ball properties (col 3 line 5-7 of Tanaka) and typically are within the JIS-C range claimed by applicant.

It would have been obvious to ensure Moriyama's core hardness is uniform for the expected advantages.

Claims 1-14 rejected under 35 U.S.C. 103(a) as being unpatentable over the Moriyama '856 Patent in view of Sullivan '356.

Moriyama discloses golf balls having the same core used by applicant (examples 1-30). Moriyama's core can have two covers (col 4 line 24-29). Moriyama does not provide details of the dual cover.

Dual covered balls having a hard, highly filled inner cover and soft outer cover are known to be advantageous (see Sullivan's abstract, claim 33, coil. 41 line 48-54).

It would have been obvious to ensure Moriyama's dual cover has the shore D and density characteristics taught by Sullivan for the expected advantages.

Applicant's arguments filed 12/26/00 have been fully considered but they are not persuasive.

Applicant argues the comparison example of Asakura '664 cannot be used to reject the claims.

Nonpreferred embodiments can form the basis of a rejection. The use of a patent reference is not limited to what the patent describes as his invention (MPEP 2123).

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The examiner provided a rationale that supports the determination that the core of Asakura's C5 inherently has the required JIS-C hardness (MPEP2112). Applicant does not deny the required hardness is present in the reference.

Applicant argues Moriyama '802 uses only one temperature to cure his core.

This argument is irrelevant to the current claims.

Applicant argues Moriyama '802 does not suggest a Shore D hardness of 70 for his intermediate layer.

Do any of applicant's claims require such a value? Why present such an argument? Moriyama suggests 65-90 anyway (col. 3 lines 43).

Applicant does not deny that the core of Moriyama '802 inherently has the required JIS-C hardness.

Arguments that the combination of Moriyama '802 and Tanaka '663 fail to disclose the features of the claimed conventions is not understood. Moriyama clearly teaches the cover limitations and Tanaka clearly teaches the core limitations.

Applicant argues Moriyama '802 and Tanaka '663 cannot be combined because of their inconsistent stiffness values for their covers.

Tanaka '663 is relied on to merely to teach what JIS-C values are typical for golf ball cores and what curing conditions/composition result in such values. There is nothing of record to lead one to believe these values ^{are} unsuitable for ball utilizing other covers.

Applicant argues neither Sullivan '356 or Moriyama '856 are anticipatory.

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No anticipatory rejections were made with these references.

Applicant argues Sullivan lacks the required Shore D hardness values for his inner and outer cover.

Sullivan prefers an inner cover hardness of 70 (col. 32 line 9) and an outer cover hardness of 56 (col. 32 line 26). These values are also exemplified in samples 32 and 33.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (703) 308-2403. The examiner can normally be reached on weekdays from 10:00 a.m. to 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D.Buttner/dh

March 21, 2001

